

REISSUE of U.S. Patent No. 5,812,249

Applicant: JOHNSON *et al.*
Serial No: 09/667,693
Filing Date: September 22, 2000
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REMARKS

In response to the First Office Action mailed August 21, 2007 (hereinafter "Office Action"), claims 10-20 have been cancelled without prejudice or disclaimer, and claims 3 and 8 have been amended. No claims have been newly added. Therefore, claims 1-9 are pending. Pursuant to 37 C.F.R. § 1.173(c), a statement of the status and support for the claim changes is provided below. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

37 C.F.R. § 1.173(c) STATEMENT

Pursuant to 37 C.F.R. § 1.173(c), the following is a statement of the status and support for the claim changes.

A. Status of the Claims

Claims 1-9 are pending in the application.

Claims 10-20 are cancelled.

More particularly, claims 1-3, 5, and 7-9 of U.S. Patent No. 5,812,249 have each been amended one time, and claims 10-20, which were newly added in the Preliminary Amendment filed on September 22, 2000, have been cancelled.

B. Support for Claim Changes

By this Amendment, dependent claims 3 and 8 have been amended.

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1. Dependent Claim 3.

The word “receiving” in line 2 of dependent claim 3 has been deleted and replaced with the recitation of “that receives” such that the feature of “...testing means receiving said calculated speed...” in line 2 of dependent claim 3 now reads “...testing means that receives said calculated speed...”.

In addition, the recitation of “display means for displaying said speed and acceleration calculated by said analyzing means” has been deleted from dependent claim 3. Exemplary support for the deletion of this feature exists in the Specification at, for example, col. 5, lines 52-55. The cited passage highlights the *optional* nature of this feature (i.e., “...the present invention may include a read out device 80...”).

2. Dependent Claim 8.

In dependent claim 8, the word “displaying” has been deleted and replaced with the word “utilizing.” Additionally, the recitation of “in an analysis of the obtained exhaust emissions data” has been newly added to the claim after the recitation of “calculated acceleration value.” As such, the second claimed feature of dependent claim 8 now recites:

utilizing the calculated speed value and the calculated acceleration value in an analysis of the obtained exhaust emissions data.

Support for this recitation may be found in the Specification at, *e.g.*, col. 1, lines 60-63; and col. 5, lines 56-62.

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REJECTION UNDER 35 U.S.C. § 102

Claims 1, 7, 9, 10, and 18 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,427,768 to Elmer *et al.* ("Elmer") [Office Action, pg. 2]. The cancellation of independent claims 10 and 18 without prejudice or disclaimer renders the rejection moot with regard to these claims. Applicants traverse the rejection of independent claims 1, 7, and 9 for at least the reason that Elmer fails to disclose each of the claimed features.

In particular, independent claim 1 positively recites, *inter alia*, the feature of calculating the acceleration of the motor vehicle:

analyzing means receiving said output signals from said first and second detectors for ***calculating*** the speed and ***acceleration*** of the motor vehicle.

[***Emphasis added***].

Independent claim 7 similarly recites:

calculating a speed value and ***an acceleration value*** from said fixed distance and each of the time measurements recorded in said step of recording.

[***Emphasis added***].

Independent claim 9 likewise recites:

calculating means receiving said time measurements from said measuring means ***for calculating an acceleration of the motor vehicle*** based on said predetermined distance.

[***Emphasis added***].

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Elmer is silent with regard to *at least* the feature of calculating an acceleration of a motor vehicle. In the Office Action, the Examiner addresses this claim recitation not by pointing to any disclosure in Elmer of calculating acceleration, but rather by merely reciting that "speed is the scalar value of velocity and acceleration is the derivative of velocity" [Office Action, pg. 2]. Simply noting the relationship between acceleration and velocity (*i.e.*, acceleration is the derivative of velocity with respect to time) is insufficient to remedy Elmer's failure to anticipate positively recited claim features.

For *at least* the foregoing reason, the rejection of independent claims 1, 7, and 9 under 35 U.S.C. § 102(b) is improper and should be withdrawn. Dependent Claims 2-6 and 8 are allowable because they depend from allowable independent claims 1 and 7 respectively, as well as for the further features they recite.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 2, 4-6, 9¹, 11, 13-17, and 19-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Elmer [Office Action, pg. 3]. Claims 3, 8, and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Elmer in view of U.S. Patent No. 5,210,702 to Bishop *et al.* ("Bishop") Jones [Office Action, pg. 4]. The cancellation of dependent claims 11-17 and 19-20 without prejudice or disclaimer renders the rejections moot with regard to these claims. Applicants traverse the rejections of

¹ Applicants note that the Examiner has rejected claim 9 under 35 U.S.C. § 102(b) [Office Action, pg. 2], and under 35 U.S.C. § 103(a) [See Office Action, pg. 3, alleging that claim 9 recites components that "would have been suggested..."]. Clarification of the alleged grounds of rejection of independent claim 9 is respectfully requested.

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dependent claims 2-6 and 8 for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

A. Dependent Claims 3 and 8

Dependent claims 3 and 8 each recite features relating to the use of speed and acceleration data with emissions data. As the Specification notes, the speed and/or acceleration of a vehicle at the time exhaust information is obtained is useful as emissions test results can be influenced by the mode of operation of the vehicle (e.g., acceleration or deceleration) [Specification, *e.g.*, col. 1, lines 18-28]. As such, Applicants disclose that obtained speed and acceleration values of a motor vehicle can be used in combination with vehicle emissions information obtained from the same motor vehicle to obtain accurate and reliable information regarding the motor vehicle being driven along the roadway [Specification, *e.g.*, col. 5, lines 56-62].

In an apparent recognition of Elmer's failure to disclose the measurement of vehicle exhaust emissions data, the Examiner relies on the teachings of Bishop:

Bishop et al is cited to show that it was known at the time of the present application to use remote sensing to measure vehicle emissions. It would have been obvious for a state government to have combined the devices of Elmer et al and Bishop et al at one station in order to reduce cost.

[Office Action, pg. 4].

Applicants disagree with the Examiner's contention. Assuming arguendo, however, that it were proper to modify Elmer to include the teachings of Bishop in the manner alleged by the Examiner (which Applicants do not concede), the rejection would still be

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improper for at least the reason that neither Elmer nor Bishop, either alone or in combination, teach or suggest the features of dependent claims 3 and 8.

In particular, if Elmer and Bishop were combined, the resulting system would apparently be capable of calculating velocity (again, Elmer fails to disclose calculating acceleration) and measuring emissions. With particular regard to dependent claim 3, however, nothing in either disclosure appears to teach or suggest that the vehicle emissions testing means receives the calculated speed from the analyzing means for obtaining exhaust emissions data. Moreover, with regard to dependent claim 8, nothing in either disclosure appears to teach or suggest utilizing the calculated speed value in an analysis of the obtained exhaust emissions data.

For at least each of the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, the rejection of dependent claims 3 and 8 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

B. Dependent Claims 2 and 4-6

As noted above, dependent claims 2 and 4-6 are allowable because they depend from allowable independent claim 1, as well as for the further features they recite.

In the Office Action, at pg. 3, the Examiner makes several unsupported assertions regarding the obviousness of the subject matter of dependent claims 2 and 4-6. The assertions are broad, conclusory statements that appear to constitute speculation. If a rejection under §103 is merely an unsupported assertion or mere speculation, the burden

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does not shift to the applicant, but rather remains on the Patent Office Examiner. *In re Donaldson*, 16 F.3d 1189, 29 U.S.P.Q.2d (BNA) 1845 (Fed. Cir. 1994).

For at least the foregoing reason, the rejection of dependent claims 2 and 4-6 under 35 U.S.C. § 103(a) is improper and should be withdrawn. Should the Examiner maintain the alleged rejections, Applicants request the Examiner set forth, for each alleged rejection, an explicitly articulated reasoning with a rational underpinning to support the legal conclusion of obviousness. For any features that the Examiner alleges are "notoriously well known," documentary evidence in support of the allegations is respectfully requested.

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CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: January 22, 2008

Respectfully submitted,

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